

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte ROBERT W. LUFFEL and DAVID P. JONES



Appeal No. 2003-0988
Application No. 09/337,802

ON BRIEF

Before ABRAMS, FRANKFORT, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 and 3 to 24, which are all of the claims pending in this application.

We AFFIRM.

BACKGROUND

The appellants' invention relates to positioning systems for moving cartridge access devices along arrays of data cartridges (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

Claims 1 and 3 to 24 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 to 24 of copending Application No. 09/371,708.

Claims 1, 3 to 7, 12 to 19 and 24 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,166,877¹ to Tadokoro et al. (Tadokoro).

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the answer (Paper No. 16, mailed October 18, 2002) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 15, filed August 8, 2002) and reply brief (Paper No. 17, filed December 12, 2002) for the appellants' arguments thereagainst.

¹ Issued December 26, 2000.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art reference, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

The provisional obviousness-type double patenting rejection

We sustain the provisional rejection of claims 1 and 3 to 24 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 to 24 of copending Application No. 09/371,708.

On June 22, 1999 the appellants filed the application under appeal and on August 9, 1999 the appellants filed Application No. 09/371,708. In the first Office action in this application (Paper No. 4, mailed May 8, 2001), the examiner provisionally rejected claims 1 to 24, all the claims then in this application, over claims 1 to 24 of copending Application No. 09/371,708 under the judicially created doctrine of obviousness type double patenting. The appellants filed a response to the first Office action (Paper No. 6, filed August 9, 2001) that did not contest the merits of this rejection. Instead, the appellants stated that they would submit a terminal disclaimer upon the examiner indicating that the claims are otherwise allowable. The examiner

repeated this rejection in the final rejection (Paper No. 7, mailed October 22, 2001). In the brief (p. 18), the appellants once again do not contest the merits of this rejection but contend that the rejection is not ripe for review. Specifically, the appellants state that "since no claims have yet issued, it is not possible to make a meaningful determination as to whether a double patenting rejection would be warranted." The appellants then request that the provisional obviousness-type double patenting rejection be held in abeyance until claims of the copending Application No. 09/371,708 are allowed.

The appellants' argument that the provisional obviousness-type double patenting rejection is not ripe for review is simply wrong. This board and its reviewing courts have sanctioned and reviewed provisional double patenting rejections based upon claims in a copending application. E.g., In re Longi, 759 F.2d 887, 892, 225 USPQ 645, 648 (Fed. Cir. 1985) (double patenting rejection over claims of three copending applications affirmed on the merits); In re Mott, 539 F.2d 1291, 1296, 190 USPQ 536, 541 (CCPA 1976) (double patenting rejection under 35 U.S.C. § 101 over claims in a copending application was held correct on the merits but reversed because rejection was made final rather than provisional); In re Wetterau, 356 F.2d 556, 558, 148 USPQ 499, 501 (CCPA 1966) (affirming provisional double patenting rejection over claims in a

compending application on the merits)²; Ex parte Karol, 8 USPQ2d 1771 (Bd. Pat. App. & Int. 1988) (the propriety of imposing a provisional rejection on the ground of double patenting of the obviousness type). Had the appellants asserted that the subject matter of claims 1 and 3 to 24 was patentably distinct from the subject matter of claims 1 to 24 of compending Application No. 09/371,708, the issue would have been reviewable by this Board. The appellants cannot strip the Board of its jurisdiction simply by failing to argue the merits. Accordingly, the decision of the examiner to provisionally reject claims 1 and 3 to 24 under the judicially created doctrine of obviousness-type double patenting is affirmed.

The anticipation rejection

We sustain the rejection of claims 1, 13 to 15 and 24 under 35 U.S.C. § 102(e), but not the rejection of claims 3 to 7, 12 and 16 to 19.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.

Verdegaal Bros. Inc. v. Union Oil Co., 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed.

² As explained in Wetterau, the provisional nature of this type of rejection meant that if a patent did not issue on the related application, the provisional rejection would evaporate. The court noted in the obviousness-type double patenting context of that case that certain benefits inured to the applicant and the USPTO through use of such a provisional procedure, i.e., by making the applicant aware at the earliest possible time of the existence of a double patenting issue, the applicant has an opportunity to elect which application to let issue, while prosecution in the USPTO is hastened.

Cir.), cert. denied, 484 U.S. 827 (1987). The inquiry as to whether a reference anticipates a claim must focus on what subject matter is encompassed by the claim and what subject matter is described by the reference. As set forth by the court in Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984), it is only necessary for the claims to "'read on' something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or 'fully met' by it."

Claims 1, 13 to 15 and 24

The appellants argue throughout both briefs that independent claims 1, 13 to 15 and 24 are novel over the disclosure of Tadokoro since these claims recite that a guide member is **integral with** a gear rack.³ The appellants point out that Tadokoro's upper and lower rack members 32 disposed on upper and lower guide rails 8 are **separate**, not **integral**, elements.⁴ The examiner in the answer responds by stating that the terms integral and one-piece are not synonymous; and that the meaning of integral is rigidly secured, fastened or welded.

³ Claims 1 and 13 recite "a first elongate guide member integral with said first elongate gear rack." Claim 15 recites "said second elongate guide member comprises an integral portion of said second elongate gear rack." Claim 24 recites "guide means integral with said elongate gear rack."

⁴ According to the appellants' argument, the term **integral** as used in this application means "one-piece."

The United States Patent and Trademark Office (USPTO) applies to the verbiage of the claims before it the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the appellants' specification. In re Morris, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997). See also In re Sneed, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983).

The examiner in the anticipation rejection before us in this appeal has interpreted the claimed guide member being **integral with** a gear rack to read on Tadokoro's upper and lower rack members 32 disposed on upper and lower guide rails 8. By this the examiner clearly meant that he interpreted the phrase "integral with" to encompass separate elements attached together as in Tadokoro. The examiner (answer, pp. 4-5) cites numerous cases and a dictionary in which the word "**integral**" had been interpreted to encompass multi-piece structures.

We conclude that the examiner's interpretation is reasonable in light of all the evidence before the Board. The court has on several prior occasions interpreted the term "**integral**" to cover more than a unitary construction. See, e.g., In re Morris, 127 F.3d at 1055-56, 44 USPQ2d at 1029, Advanced Cardiovascular Sys. v. Scimed Life

Sys., 887 F.2d 1070, 1074, 12 USPQ2d 1539, 1542 (Fed. Cir. 1989); In re Kohno, 391 F.2d 959, 157 USPQ 275 (CCPA 1968), In re Dike, 394 F.2d 584, 157 USPQ 581 (CCPA 1968), In re Larson, 340 F.2d 965, 144 USPQ 347 (CCPA 1965), and In re Clark, 214 F.2d 148, 102 USPQ 241 (CCPA 1954). Absent an express definition in the specification, the fact that the appellants can point to definitions or usages that conform to their interpretation does not make the examiner's definition unreasonable when the examiner can point to other sources that support his interpretation. In fact, the appellants' specification implicitly discloses embodiments other than the preferred embodiment in which the elongate guide member 50 takes the form of a turned-up edge of the gear rack 20.⁵

For the reasons set forth above, the appellants argument fails to persuade that the subject matter of claims 1, 13 to 15 and 24 is novel. Accordingly, the decision of the examiner to reject claims 1, 13 to 15 and 24 under 35 U.S.C. § 102(e) is affirmed.

⁵ Page 10, lines 16-20, of the specification states that "[t]he first or lower elongate gear rack 20 also may be provided with an elongate guide member 50 which, in one preferred embodiment, may take the form of a turned-up edge of the elongate gear rack 20, as is also best seen in Figure 2."

Claims 3 to 7 and 16 to 19

The appellants argue throughout both briefs that dependent claims 3 to 7 and 16 to 19 are novel over the disclosure of Tadokoro since these claims recite that the first elongate guide member comprises first and second opposed bearing surfaces and that the first bearing is mounted to the cartridge access device to slidably engage the first and second opposed bearing surfaces of the first elongate guide member. We agree. In that regard, we agree with the appellants that Tadokoro's guide rollers 33 which roll on first and second opposed surfaces of the guide rail 8 (see Figure 22) do not **slidably** engage first and second opposed surfaces of the guide rail 8. Accordingly, the decision of the examiner to reject claims 3 to 7 and 16 to 19 under 35 U.S.C. § 102(e) is reversed.

Claim 12

The appellants argue throughout both briefs that dependent claim 12 is novel over the disclosure of Tadokoro since it recites that the pinion drive apparatus comprises: a motor having a shaft; a worm attached to the shaft of the motor; and a worm gear operatively connected to the first and second drive pinions, the worm gear mounted to engage the worm mounted to the shaft of the motor. We agree. In that regard, the examiner's determination (answer, p. 4) that Tadokoro in Figure 20 shows motor 34 with worm and worm gear 39 attached to the shaft of motor 39 such that gear

39 is operatively connected to pinions 41 is incorrect. Tadokoro does not teach a worm attached to the shaft of the motor 34 but instead teaches a pulley 35. Tadokoro also does not teach a worm gear mounted to engage the worm mounted to the shaft of the motor but instead teaches a belt 36 for transmitting drive from pulley 35 to shaft 38 via drive pulley 37. Additionally, we note that Tadokoro's drive train from motor 34 to pinions 41 does not utilize either a worm or a worm gear.⁶ Accordingly, the decision of the examiner to reject claim 12 under 35 U.S.C. § 102(e) is reversed.

CONCLUSION

To summarize, the decision of the examiner to provisionally reject claims 1 and 3 to 24 under the judicially created doctrine of obviousness-type double patenting is affirmed; the decision of the examiner to reject claims 1, 13 to 15 and 24 under 35 U.S.C. § 102(e) is affirmed; and the decision of the examiner to reject claims 3 to 7, 12 and 16 to 19 under 35 U.S.C. § 102(e) is reversed.

Since at least one rejection of each of the appealed claims has been affirmed, the decision of the examiner is affirmed.

⁶ Drive gear 39 is a pinion-type gear not a worm-type gear.

AFFIRMED

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